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Andrew S. Poulsen

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EXAMINER

MOUTAOUAKIL, MOUNIR

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**BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES**

Application Number: 10/671,924  
Filing Date: September 24, 2003  
Appellant(s): POULSEN, ANDREW S.

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Gregory W. Osterloth  
Reg. No: 36,232  
For Appellant

**EXAMINER'S ANSWER**

This is in response to the appeal brief filed 06-26-2010 appealing from the Office action mailed 10-28-2009.

**(1) Real Party in Interest**

A statement identifying by name the real party in interest is contained in the brief.

**(2) Related Appeals and Interferences**

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

**(3) Status of Claims**

The following is a list of claims that are rejected and pending in the application:

Claims 1-12 and 14-25.

**(4) Status of Amendments After Final**

No amendment after final has been filed.

**(5) Summary of Claimed Subject Matter**

The summary of claimed subject matter contained in the brief is correct.

**(6) Grounds of Rejection to be Reviewed on Appeal**

The appellant's statement of the grounds of rejection to be reviewed on appeal is correct.

**(7) Claims Appendix**

The copy of the appealed claims contained in the Appendix to the brief is correct.

**(8) Evidence Relied Upon**

Loveland: US 6,782,413

Lashley et al : US 7,003,085

**(9) Grounds of Rejection**

The following ground(s) of rejection are applicable to the appealed claims:

***Claim Rejections - 35 USC § 112***

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claims 1-12 and 14-25 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

3. Regarding claims 1-12 and 14-25, the specification does not contain sufficient information to enable the recitation of "an electronic test instrument". The specification does not explain what is the test instrument, what does the test instrument do, what is being tested, how does the test instrument generate the instrument data, what is the purpose if the test instrument and who will benefit from the tests generated. The specification provides insufficient guidance to enable one skilled in the art to perform the method of claims 1-12 and 14-25.

***Claim Rejections - 35 USC § 103***

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

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(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 1-12, 14-17, and 18-24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Loveland (US 6,782,413).

Regarding claim 1. Loveland discloses an instrument system (fig.2). The system comprises an electronic instrument (130, 134, or 132); and a network interface module (114) having a first connector for connecting with the electronic test instrument (the connection between 130 and 114), a second connector for connecting with a voice module (137 and the connection between 137 and 114), and a third connector for connecting with a network (116), wherein the network interface module and the electronic instrument are configured to interchange instrument data via the first connector (computers, e-mails and servers exchange data through module 114), wherein the network interface module and the voice module are configured to interchange voice data via a second connector (137 communicate with the WAN through the 114), wherein the voice data is in the form of an electronic signal (it is inherent that voice data is in a form of electronic signal), wherein the network interface module and the network are configured to interchange combined voice and instrument data via the third connector (fig.2, 116 and col.7, lines 16-30. The network interface 114 combines voice and data and transmits them to the WAN through the third link 116), and wherein the network interface module is configured to effect transposition between combined voice and instrument data and separate instrument data and voice data (fig.2, col.7, lines 16-30).

Claim 1 discloses all the limitations of the claimed invention with the exception that the electronic instrument is an electronic test instrument. However, examiner takes an official notice that it is well known and preferred in the art the computers can test the network by sending test packets, ping and traceroute commands to test the network, determine network topology, and determine liveness of network terminals or elements. Thus, it would have been obvious to a person of ordinary skill in the art at the time of the invention to test the network using the electronic device of Loveland for at least the reasons stated above.

Regarding 2. Loveland discloses an instrument system wherein interchange of instrument data between the network interface module and the electronic instrument comprises the reception of instrument data from the electronic instrument by the network interface module (fig.2, 114, 128, 130, 132, and 134).

Regarding claim 3. Loveland discloses an instrument system wherein interchange of instrument data between the network interface module and the electronic instrument comprises the transmission of instrument data from the network interface module to the electronic instrument (fig.2. 114, 128, 130, 132, and 134).

Regarding claim 4. Loveland discloses an instrument system wherein interchange of voice data between the network interface module and the voice module comprises the reception of voice data from the voice module by the network interface module (fig.2, 114, and 137).

Regarding claim 6. Loveland discloses an instrument system wherein interchange of voice data between the network interface module and the voice module comprises the transmission of voice data from the network interface module to the voice module (fig.2, 112, and 137).

Regarding claim 7. Loveland discloses an instrument system that further comprising the voice module, wherein the voice module comprises a transducer (137), wherein the transducer transforms electronic voice data into sounds replicating the human voice (137).

Regarding claim 8. Loveland discloses an instrument system wherein interchange of combined voice and instrument data between the network interface module and the network comprises the reception of a data stream comprising combined instrument data and voice-over-IP data from the network by the network interface module and wherein the network interface module transposes the combined instrument data and voice-over-IP data into separated instrument data and voice data (col.7, lines 16-31).

Regarding claim 9. Loveland discloses an instrument system wherein the network interface module transposes separated instrument data and voice data into combined instrument and voice-over-IP data and wherein interchange of combined voice and instrument data between the network interface module and the network comprises the transmission of a data stream comprising the combined instrument and voice-over-IP data from the network interface module to the network (col.7, lines 16-31).

Regarding claims 14-16. Loveland discloses an instrument system wherein the voice module comprises a handset (137), wherein the handset/headset/speaker is used for communication with an operator (element 137 is used to communicate with people).

Regarding claim 18. Loveland discloses an instrument system wherein the network is a local area network (LAN) (fig.2, 110, col.6, lines 23-28).

Regarding claim 19. Loveland discloses an instrument system wherein the network is the internet (it is inherent that the network is the internet, since they exchange VOIP is supported by the system).

Regarding claim 20. Loveland discloses an instrument system wherein the network is a Wide-Area-Network (110).

Regarding claim 21. Loveland discloses an instrument system wherein the system enables communication between the electronic instrument and a remote system (fig.2).

Regarding claim 22. Loveland discloses an instrument system, wherein the system enables communication between an operator located with the electronic instrument and another individual located remote from the operator's location (fig.2).

Regarding claim 23. Loveland discloses an instrument system wherein diagnostic instrument data from the electronic instrument is transmitted to a remote data analysis instrument (fig.2).



Regarding claim 5. Loveland discloses and instrument system that further comprising the voice module, wherein the voice module comprises a transducer (it is inherent the phone set includes a transducer), wherein the transducer transforms the human voice into electronic voice data (it is inherent that the phone set 137 converts human voice into an electronic signal).

Regarding claim 10. Loveland discloses an instrument system that further comprising the voice module (137).

With respect to claims 5 and 10, Loveland discloses all the limitations of the claimed invention with the exception that the test instrument comprises a chassis and that the voice module is built into the chassis. However, it would have been obvious matter of design choice to modify Loveland by physically attaching all the elements listed above together into a chassis, since applicant has not disclosed that having all the elements, listed above, physically attached together into a chassis solves any stated problem or is for particular purpose and it appears that the system would function/perform equally well with the elements being separate.

Regarding claims 11 and 17. Loveland discloses all the limitations of the claimed invention with the exception that the voice module, the network module and the electronic instrument are physically attached. However, it would have been obvious matter of design choice to modify Loveland by physically attaching all the elements listed above together, since applicant has not disclosed that having all the elements, listed above, physically attached together solves any stated problem or is for particular

purpose and it appears that the system would function/perform equally well with the elements being separate.

Regarding claim 12. Loveland discloses an instrument system wherein the transducer is a speaker (137).

Regarding claim 24. Loveland discloses all the limitations of the claimed invention.

Loveland fails to disclose connecting to the network wirelessly. However, an official notice is taken that the person of ordinary skill in the art at the time of the invention will know how to modify the system to connect to the network wirelessly. The person of ordinary skill in the art will notice the need to connect to the network wirelessly to eliminate connection cabling, and enjoy portability and flexibility.

6. Claim 25 is rejected under 35 U.S.C. 103(a) as being unpatentable over Loveland in view of Lashley et al (US 7,003,085). Hereinafter, referred to Lashley.

Loveland discloses all the limitations of the claimed invention with the exception that the test instrument comprises a call button to connect the user to a support location to receive help. However, Lashley, from the same field of endeavor, discloses that a customer or user may simply press a customer support call button 116 to easily and quickly connect with a customer service representative for assistance and support. Thus, it would have been obvious to a person of ordinary skill in the art at the time of the invention to add a button, as taught by Lashley, into the method of Loveland for at least the reasons stated above.

**(10) Response to Argument**

**A. Rejection under 35 U.S.C 112 1<sup>st</sup> paragraph: Claims 1-12 and 14-25.**

Appellant contends that the 112 1st paragraph rejection is erroneous as a **"patent need not teach, and preferably omits, what is well known in the art"**; moreover, appellant argues that the specification of the current application is replete with description of the electronic test instrument.

In response to appellant's argument, the specification does not contain sufficient information to enable a person of ordinary skill in the art and to enable the broad scope of the claimed invention as it is not clear what is meant by the "electronic test instrument" as the device title can refer to many different types of testing devices available in the realm of technology in general. For instance, many things can be tested, from packet transmission, connection reliability, delay, to voltage and current levels in a circuit. Therefore, the specification does not shed any light or explain the recitation of "electronic test instrument" or provide any examples as in what kind of testing the "electronic test instrument" may be used to benefit the person of ordinary skill in the art. Consequently, the specification provides insufficient guidance to enable one skilled in the art to perform the method of claims 1-12 and 14-25 (see *In re Goodman* 29 USPQ2d 2010).

**B. Rejection under 35 U.S.C 103 (a): claims 1-12 and 14-24.**

Appellant argues that Loveland fails to teach the limitations of the claimed invention and particularly Loveland does not comprise an electronic test instrument.

In response to appellant's argument, examiner has already admitted that the prior art of record does not explicitly include an electronic test instrument. However, examiner took an official notice that it is well known and preferred in the art that the computers can test the network by sending test packets, ping and traceroute commands to test the network, determine network topology, and determine liveliness of network terminals or elements in a network. Thus, it would have been obvious to a person of ordinary skill in the art at the time of the invention to test the network using the electronic device of Loveland for at least the reasons stated above. The official notice was supported by the NPLs listed in the PTO-892 dated 10-28-2009.

Appellant further argues that the recitation "electronic test instrument" needs to be given a weight or a meaning.

In response to appellant's argument, examiner had stated many times that the recitation is broadly interpreted as the specification of the current application does not specify what a test instrument is.

Appellant argues that the examiner has never made a case for why it would be obvious to a PHOSITA to configure Loveland device as an "electronic test instrument".

In response to appellant's argument, it would have been obvious to a person of ordinary skill in the art to benefit from the benefits of testing devices, as they are notoriously known in the art, to test the network in order to generate reports with respect to connection statuses, delay, devices liveliness and many more.

Appellant argues, that the combination, configuring Loveland device to be a testing device, would not work and would not be obvious to a person of ordinary skill in the art.

In response to appellant's argument, examiner would like to direct the board's attention that the prior art of record teaches all the limitations of the claimed invention with the exception that Loveland device is not a testing device. The testing deficiency was cured by configuring Loveland's device to conduct tests such as pinging and trace-routing, which will render Loveland's device a testing device. Therefore, it would have been obvious to a person of ordinary skill in the art at the time of the invention to configure Loveland's device to update network connection maintaining connection, and rerouting data efficiently in the case of a link failure.

With respect to claims 5 and 10, appellant contends that Loveland does not teach a voice module that is built into the chassis of an electronic test instrument.

In response to appellant's argument, With respect to claims 5 and 10, Loveland discloses all the limitations of the claimed invention with the exception that the test instrument comprises a chassis and that the voice module is built into the chassis. However, it would have been obvious matter of design choice to modify Loveland by physically attaching all the elements listed above together into a chassis, since applicant has not disclosed that having all the elements, listed above, physically attached together into a chassis solves any stated problem or is for particular purpose and it appears that the system would function/perform equally well with the elements being separate.

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**C. Rejection under 35 U.S.C 103 (a): Claim 25**

Appellant content that claim 2 is allowable because, Lashley et al does cure the claimed deficiencies of Loveland.

In response, the rejection is maintained as Loveland clearly teaches all the limitation as discussed above.

**(11) Related Proceeding(s) Appendix**

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

/M. M./

Examiner, Art Unit 2476

Conferees:

/Phirin Sam/

Primary Examiner, Art Unit 2476

/Ayaz R. Sheikh/

Supervisory Patent Examiner, Art Unit 2476